

REMARKS

In accordance with the foregoing, claims 1-29 have been amended. No new matter has been added. Claims 1-29 are pending and under consideration.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

On page 2 of the Office Action, claims 1-29 were rejected under 35 U.S.C. §112, second paragraph as being indefinite. Applicants made a bona-fide attempt to clarify the claims to overcome this rejection. The scope of the claims has not been altered. No new matter has been added. The amendments are fully supported by the originally filed specification and claims.

In light of the amendments to the claims, Applicants respectfully request withdrawal of the claim rejections under 35 U.S.C. §112, second paragraph.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

On page 2 of the Office Action, claims 1-3, 8, 9, and 11-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2005/0108112 by Ellenson et al. (hereinafter "Ellenson") in view of Official Notice.

Ellenson relates to a computer-based system facilitating the real-time pricing, sale, and appraisal of used vehicles using appraisal profiles including prices of used vehicle models satisfying a plurality of base conditions.

Independent claim 1 recites a sales support server communicating via a network with an estimated price database storing specification information for each vehicle of a plurality of vehicles and corresponding estimated prices, a dealer terminal used by a dealer, and a client terminal used by a client. In the Office Action, it is stated that "Ellenson teaches a system for facilitating the real-time pricing, sale and appraisal of the vehicles." While the above statement is true, it also proves that Ellenson does not teach or suggest the sales support server described in claim 1's preamble, which is linked to a database, and two terminals (a dealer terminal and a client terminal). As stated in MPEP 2111.02 (I), "[any] terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation."¹ The Office Action's argument that claim 1 is obvious over Ellenson in view of Official Notice is defective because it starts by using a preamble describing Ellenson's system without showing any evidence that the structure described in the preamble of claim 1 is taught or suggested by Ellenson's system.

¹ See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, (Fed. Cir. 1989).

Further, in support of the claim 1 rejection, it is alleged that the reception unit which receives specification information and an estimation request from the client terminal, is disclosed in paragraph [0027] of Ellenson. However, the indicated paragraph from the Summary of the invention section is directed to a method of facilitating the real-time pricing, sale, and appraisal of a used vehicle and recites the steps of the method. Applicants submit that the indicated paragraph does not teach or suggest the reception unit receiving specification information and an estimation request from the client terminal. The method disclosed in paragraph [0027] of Ellenson includes a step of receiving input data and a step of receiving a request for a guaranteed price. Ellenson does not specify what supplies the input data (specifically, that it is received from the client terminal) because, as discussed above, a communication between the client terminal and the Ellenson's system is not foreseen. Additionally, in paragraph [0027] of Ellenson, it is stated that "the input data associated with an appraisal profile comprises check writing prices for a plurality of used vehicle models, where each check writing price represents a **price** offered by the respective buyer to purchase a used vehicle [...]. " Neither the specification information nor the estimation request can include a price since the very reason of inputting this information is to receive in return an estimated price. That is, the input data cannot correspond to the specification information and the estimation request recited in claim 1, and it is a teaching contrary to the present invention.

On page 3, lines 1-3 of the Office Action, it is alleged that the reading unit which reads an estimated price from the estimated price database based upon the specification information is disclosed in paragraph [0028] of Ellenson. The indicated paragraph is directed to a system for facilitating the real-time pricing sale, and appraisal of a used vehicle including a system database, a user interface and at least one module programmed to generate at least one guaranteed price. None of the enumerated elements of the system disclosed in the paragraph [0028] of Ellenson teaches or suggests the reading unit reading an estimated price from the estimated price database based upon the specification information as recited in claim 1.

In the Office Action at page 3, paragraphs [0071] and [0094] of Ellenson are indicated as teaching or suggesting the first transmission unit, the second transmission unit and the control unit. Paragraph [0071] discloses details of step 224 of FIG. 5 from Ellenson. The paragraph includes no references to structural components that would teach or suggest the first transmission unit, the second transmission unit or the control unit. Paragraph [0094] states:

With respect to elements of the pricing system for facilitating the pricing and sale of a vehicle as described in this specification, it will be apparent to those skilled in the art that the execution of various tasks associated with the methods of the

present invention need not be performed by the particular component specified in the description of the preferred and variant embodiments of the invention, and that many configurations of the pricing system are possible without departing from the scope of the present invention. For example, it will be obvious to those skilled in the art that the performance of tasks by a pricing module may be performed by a different module, or through the use of multiple modules. With respect to elements of the pricing system for facilitating the pricing and sale of a vehicle as described in this specification, it will be apparent to those skilled in the art that the execution of various tasks associated with the methods of the present invention need not be performed by the particular component specified in the description of the preferred and variant embodiments of the invention, and that many configurations of the pricing system are possible without departing from the scope of the present invention. For example, it will be obvious to those skilled in the art that the performance of tasks by a pricing module may be performed by a different module, or through the use of multiple modules.

Applicants submit that the above-cited paragraph [0094] contains no teaching or suggestion of the first transmission unit, the second transmission unit or the control unit as recited in claim 1. Relative to the first transmission unit the paragraph [0027] aimed at the method as discussed above is also indicated, but this paragraph does not explicitly disclose any transmission unit in a system as described in claim 1.

The Examiner submits "Ellenson does not teach that said unit (server) includes first and second units for performing said functionalities." The Examiner takes Official Notice that "it is old and well known that software/hardware modules are frequently upgraded due to development in technology. ¶ Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ellenson to include that said functionalities are performed by first and second software/hardware units, because it would be advantageously allow to upgrade each units separately."

Applicant respectfully traverses the Official Notice and demands authority for the statement. Applicants specifically points out the following errors in the Office Action.

First, the Office Action uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

Any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the functionalities of the first and second transmission units are not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious

character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the assertion in the Official Notice. See M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the rejection is based, at least in part, on personal knowledge. 37 C.F.R. § 1.104(d)(2) requires such an assertion to be supported with an affidavit when called for by the Applicant. Thus, Applicant calls for support for the assertion with an affidavit.

To summarize, Ellenson does not teach or suggest all the elements of the sales support server as claimed in claim 1.² Claim 1 is patentable over the cited prior art. Claims 2-17 depending on claim 1 are also patentable at least by inheriting patentable features from claim 1.

Independent claim 18 recites a sale support server communicating with an estimated price database, a dealer terminal and a client terminal. The sale support server includes reception means, reading means, first transmission means, second transmission means, and control means. Ellenson does not disclose "A sales support server which communicates with an estimated price database storing specification information for a plurality of vehicles and corresponding estimated prices of the vehicles, a dealer terminal used by a dealer of vehicles, and a client terminal used by a client." Further, Ellenson does not teach or suggest "reception means for receiving specification information of a vehicle and an estimation request from said client terminal", "reading means for reading an estimated price from said estimated price database based upon the specification information of the vehicle", "first transmission means for sending the estimated price read by said reading means to said client terminal without requesting a dealer estimated price", "second transmission means for sending the specification information received by said reception means to said dealer terminal in order to request the dealer estimated price from said dealer terminal" and "control means for deciding whether to send the estimated price or to request the dealer estimated price from said dealer terminal, and controlling accordingly said first transmission means or said second transmission means."

² See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Independent claim 22 is directed to a sales support system including a sales support server, a dealer terminal, a client terminal and an estimated price database. Paragraph [0028] of Ellenson is indicated as disclosing all the above-enumerated components. The system for facilitating the real-time pricing sale, and appraisal of a used vehicle disclosed in the paragraph [0028] of Ellenson includes a system database, a user interface and at least one module programmed to generate at least one guaranteed price. The system of Ellenson does not teach or suggest at least the client terminal, the dealer terminal and the sales support system having the structure disclosed in claim 22. In the Office Action, arguments similar to the arguments related to claim 1 are presented to support the rejection of claim 22 relative to disclosing the structural elements of the sales support system. Applicants respectfully traverse the rejection as discussed relative to claim 1.

Independent claim 26 is directed to a sales support method to be performed by a sales support server managed by a manufacturer of vehicles, the sales support server communicating with a dealer terminal used by a dealer of vehicles, a client terminal used by a client, and an estimated price database which stores specification information for vehicles and corresponding estimated prices of the vehicles. First, Applicants submit that Ellenson does not disclose a method to be performed by a sale support system as recited in Claim 26. On pages 10-11 of the Office Action, it is alleged that the decision, the first transmission and the second transmission are disclosed by paragraph [0071] of Ellenson. Applicant respectfully submits the paragraph [0071] does not teach or suggests the decision, the first transmission and the second transmission as recited in claim 26. Therefore claim 26 and claims 27-29 depending on claim 26 are also patentable over the cited prior art.

On page 12 of the Office Action, claims 4-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ellenson in view of U.S. Patent Application Publication 2003/0061179 by Reece (hereinafter "Reece"). Reece is directed to "a telecommunications system where the price of communications is established by the network operator ("the seller") in accordance with actual or predicted demand in such fine increments that it becomes "dynamic" from the user's perspective because the prices vary to such a high degree that individual users ("buyers") are unable to execute a rational economic decision without incurring prohibitively high transaction costs." Reece does not obviate the above-identified defect of Ellenson and does not teach or suggest all the elements of the system as disclosed in claim 1.

On page 12 of the Office Action, claims 4-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ellenson in view of U.S. Patent Application Publication 2003/0135429 by Pous et al. (hereinafter "Pous"). Pous discloses a system providing custom engineered

products to a customer, the customer selecting from identified unavailable products, attributes, or variances stored in a memory or inputting a desired specification and the system comparing the customer selection to available products for alternative suggestions and for advanced material ordering. Pous does not cure the above-identified defect of Ellenson of not teaching or suggesting all the elements of the system as disclosed in claim 1 from which claims 4-7 depend.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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